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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,467

03/29/2004

Bill J. Peck

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AGILENT TECHNOLOGIES INC.

INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT.

MS BLDG. E P.O. BOX 7599

LOVELAND, CO 80537

EXAMINER

CROW, ROBERT THOMAS

ART UNIT

PAPER NUMBER

1634

NOTIFICATION DATE

DELIVERY MODE

10/15/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/813,467

Applicant(s)

PECK ET AL.

Examiner

Robert T. Crow

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 28-59 and 61.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 11. does NOT place the application in condition for allowance because: Applicant asserts on pages 7-9 of the Remarks filed 24 September 2007 that the examiner's interpretation of the claimed invention is incorrect and that the claims do not teach a method in which polymers are presynthesized and then deposited at specific sites to produce an addressable array.

The assertion is noted, however it is maintained that the claims do in fact encompass deposition of presynthesized polymers. The claims are drawn to a method of producing an addressable array. The method steps define a) contacting blocked monomers to locations of a substrate (e.g. beads), b) removing blocking groups and c) reiterating steps to produce an addressable array. The claims do not require steps a-c be preformed at addressed locations of an addressable array. The claims merely required that an addressable array be produced. The claim defines the "method comprising" a, b, c. The open claim language "comprising" encompasses additional steps e.g. cleaving the polymers and immobilizing them onto an addressable array. Hence, the cited art is encompassed by the claims. It is maintained that the invention, as claimed, is obvious in view of the cited prior art.

Applicant further asserts on page 9 of the Remarks that the alternative application of the synthesis steps of Anderson et al to either Schleifer (A) or Schleifer (B) because the Schleifer references do not teach the in situ production of an addressable array.

However, Schleifer (A) explicitly teaches an additional embodiment wherein in situ synthesis method are performed (column 10, lines 30-35). In addition, Schleifer (B) teaches Figure 2, which depicts the in situ synthesis of oligonucleotides as "the method of the present invention (column 5, lines 1-2). Thus, Applicant's assertion regarding the teachings of Schleifer (A) and (B) is incorrect.

Applicant's remaining arguments on pages 9-12 of the Remarks rely on arguments set forth to address the rejections of claims 28-36, 38-44, 46-48, 50-52, 54-59, and 61 under 35 USC 103(a). Since the arguments regarding claims 28-36, 38-44, 46-48, 50-52, 54-59, and 61 were not persuasive, the rejections of the remaining claims are maintained.

/Jehanne Sitton/
10/5/2007

